



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/810,720

03/29/2004

Byung-Jin Kim

1740-000011/US/COA

9364

30593 7590 12/11/2008
HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON, VA 20195

EXAMINER

CHEVALIER, ROBERT

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

12/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/810,720	Applicant(s) KIM ET AL.	
	Examiner ROBERT CHEVALIER	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/28/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 14 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14, 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3, 14, 26-28, have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al (P.N. 2002/0057899) in view of both Ando et al (P.N. 7,426,334) and Mori et al (P.N. 2006/0239647).

Nakano et al discloses a video reproducing apparatus that shows substantially the same limitations recited in claims 1-2, including the feature of outputting an I picture

Art Unit: 2621

and a number of P-pictures as still picture based on reproduced video data as specified in the present claims 1-2. Applicant's attention is directed to Nakano et al's claim 13, wherein it is disclosed that reproducible video data is decoded using a decoding portion and video still picture data is generated from the decoded video data using still picture coding portion.

Nakano et al fails to specifically disclose the feature of the management data including management information indicating whether the video data includes the still picture as specified in the present claims 1-2.

Ando et al disclose a video recording/reproducing apparatus which includes the feature of the management data including management information managing and identifying the still picture as specified in the present claims 1-2. Applicant's attention is directed to Ando et al's claim 2, where it is disclosed management information including the capability of managing and identifying still picture and the video data reproducing from the recording medium.

It would have been obvious to one skilled in the art to modify the Nakano et al video apparatus wherein the recording/reproducing means provided thereof would incorporate the capability of a management data including management information managing and identifying the still picture in the same conventional manner as is shown by Ando et al. The motivation is to have a better control during reproduction operation, thereby, increase the efficiency of the apparatus as suggested by Ando et al.

The proposed combination of Nakano et al and Ando et al indicated above fails to disclose the claimed feature of the management data including clock reference

information and still presentation information that indicate how long the still picture is to be reproduced as specified in claims 1-2.

Mori et al discloses a video/still picture recording/reproducing apparatus that shows the feature of the management data indicating how long a still picture is to be reproduced as specified in the present claims 1-2. (See Mori et al's page 15, paragraph [0249]).

It would have been obvious to one skilled in the art to modify the proposed combination indicated above wherein the recording/reproducing means provided thereof would incorporate the capability of the management data including management information indicating how long a still picture is to be reproduced in the same conventional manner as is shown by Mori et al. The motivation is to have a better control during reproduction operation, thereby, increase the efficiency of the apparatus as suggested by Mori et al.

With regard to claim 3, the feature of the number of P-pictures being greater than 1 would be present in Nakano et al. (See Nakano et al's Figure 6).

5. Claims 14, 26-28, are rejected under 35 U.S.C. 102(e) as being anticipated by Ando et al (P.N.6,424,797) in view of Mori et al (P.N. 2006/0239647).

Ando et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claim 14, including the feature of providing video data and of providing management data indicating if the video data does not include a still picture as specified in the present claim 14. Applicant's attention is directed to Ando et al's claim 2, where it is disclosed management information including

Art Unit: 2621

the capability of managing and identifying still picture and the video data reproducing from the recording medium.

Ando et al fail to disclose the claimed feature of the management data including clock reference information and still presentation information that indicate how long the still picture is to be reproduced as specified in claim 14.

Mori et al disclose a video/still picture recording/reproducing apparatus that shows the feature of the management data indicating how long a still picture is to be reproduced as specified in the present claim 14. (See Mori et al's page 15, paragraph [0249]).

It would have been obvious to one skilled in the art to modify the Ando et al's apparatus wherein the recording/reproducing means provided thereof would incorporate the capability of the management data including management information indicating how long a still picture is to be reproduced in the same conventional manner as is shown by Mori et al. The motivation is to have a better control during reproduction operation, thereby, increase the efficiency of the apparatus as suggested by Mori et al.

With regard to claims 26-28, the feature of the management area and the data area being separated by at least one header area including header information for the video data as specified thereof is present in Ando et al. (See the management information shown in Ando et al's Figure 1, part B).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-3, 14, 26-28 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT CHEVALIER whose telephone number is (571)272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT CHEVALIER/
Primary Examiner, Art Unit 2621
December 7, 2008.